

REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.116, are respectfully requested.

By the foregoing amendment, claim 1 has been amended so that the chain isoprenoid fatty acid esters represented by the formula (I) is directed to one wherein the alcohol constituting the chain isoprenoid fatty acid esters is geranyl geraniol. Claim 4 has also been amended for grammatical purposes. Additionally, claims 5, 11 and 13-15 have been canceled without prejudice or disclaimer to the subject matter recited therein. Applicants reserve the right to file one or more continuation and/or divisional application(s) directed to any of the deleted or canceled subject matter. No new matter has been added.

Turning now to the Office Action, claims 1-4, and 11-12 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Tahara et al. (U.S. Patent No. 4,642,314 or U.S. Patent No. 4,738,801). This rejection is respectfully traversed.

For a prior art reference to be anticipatory, every element of the claimed invention must be disclosed in a single item of prior art in the form literally defined in the claim. See, e.g., *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 213 U.S.P.Q. 81, 90 (Fed. Cir. 1986). This requirement for anticipation has not been met with respect to the claims of the subject application.

The claims of the subject application relate to an improver for bone metabolism comprising the chain isoprenoid fatty acid esters wherein the alcohol constituting the chain isoprenoid fatty acid esters is geranyl geraniol. However, both Tahara et al. patents (U.S. Patent Nos. 4,642,314 and 4,738,801) disclose the chain isoprenoid fatty acid esters wherein the alcohol constituting the chain

isoprenoid fatty acid esters is phytol or dihydrophytol. Since neither of the patents cited by the Examiner teach or suggest the alcohol constituting the chain isoprenoid fatty acid esters being geranyl geranoil, every element of applicants' claimed invention is not disclosed by the Tahara et al. patents. Thus, the Tahara et al. patents do not, and can not, anticipate the claimed invention. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Claims 5-10 have also been rejected under 35 U.S.C. § 112, second paragraph, as purportedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse this rejection. However, to expedite prosecution in this present application and not to acquiesce to the Examiner's rejection, claim 5 has been canceled. The Examiner's rejection in this regard has thus been rendered moot.

Further and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited.

In the event that there are any questions relating to this Amendment and Reply, or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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